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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/029,107 | 12/20/2001 | Scott A. Olson | CM03409J | 3391 |

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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/029,107 | Applicant(s) OLSON ET AL. | |
| | Examiner Dan Kesack | Art Unit 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. In response to amendment entered November 9, 2005, claims 1-19 are cancelled and new claims 20-24 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 20-22, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van den Heuvel et al., U.S. Patent No. 5,301,359, in view of Noreen et al., U.S. Patent Application Publication No. 2002/0183059.

Claim 20, Van den Heuvel teaches a method for configuring a subscriber unit for operation in a wireless communication system, comprising obtaining over and RF broadcast (column 3 lines 37-40), communication information necessary for the subscriber unit to automatically communicate with a brokering agent (column 3 line 56 – column 4 line 2), the subscriber unit selecting a particular service provider from the plurality of providers based on offerings of the wireless services (column 4 lines 3-9), using the communication information to communicate to the brokering agent the identity of the particular wireless service (column 4 lines 9-22), establishing a subscription relationship with the particular service provider brokered by the agent and configuring the subscriber unit to operate in a mode that supports interaction with the particular service provider (column 4 lines 22-31). Examiner notes that the recitation that the brokering agent is an independent business is regarded as intended use of the Applicant's invention, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

Claim 20, Van den Heuvel fails to teach the RF broadcast being a broadcast RF subcarrier of a commercial FM broadcast station.

Noreen discloses an interactive system and method for use with broadcast media, wherein a two-way wireless subscriber unit communicates a commercial FM broadcast containing additional information data encoded within (paragraphs 11-12). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Van den Heuvel to include the use of a commercial FM broadcast because of the advantages afforded by such a system, as described by Noreen (paragraph 6).

Claims 21, 22, Van den Heuvel teaches the selection of service is based upon information concerning the offerings of the wireless services communicated to the subscriber unit over the RF broadcast (column 3 lines 56 – column 4 line 9).

Claim 24, Van den Heuvel teaches the selection of service is performed at the subscriber unit and is communicated to the brokering agent using the communication information (column 4 lines 3-17).

5. Claim 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Van den Heuvel and Noreen as applied to claims 20-22, and 24 above, and further in view of Snelgrove et al., U.S. Patent Application Publication No. 2002/0058532.

Claim 23, Van den Heuvel and Noreen fail to teach communicating criteria from the subscriber unit to the brokering agent, and the brokering agent selecting services meeting the criteria.

Snelgrove discloses a method and system for negotiating telecommunication resources wherein a criteria for the service is supplied to a brokering agent, and the brokering agent selects a service based on available services meeting said criteria (paragraphs 77-78). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify to the teachings of Van den Heuvel and Noreen to include the use of a selection criteria because Van den Heuvel teaches automatic selection of service, and selection criteria would give the subscriber unit the desirable feature of eliminating those services which lack features necessary to the subscriber unit.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER